

Supreme Court, U.S.

FILED

DEC 19 1991

SEAL OF THE CLERK

IN THE
Supreme Court of the United States
 OCTOBER TERM, 1991

YOUNG & RUBICAM INC.,

Petitioner,

—v.—

BETTE MIDLER,

Respondent.

PETITION FOR A WRIT OF CERTIORARI
 TO THE UNITED STATES COURT OF APPEALS
 FOR THE NINTH CIRCUIT

**PETITION FOR A
 WRIT OF CERTIORARI**

ROBERT M. CALLAGY
 MARIO AIETA
 GILLIAN LUSINS
 SATTERLEE STEPHENS BURKE & BURKE
Attorneys for Petitioner
Young & Rubicam, Inc.
 230 Park Avenue
 New York, New York 10169
 (212) 818-9200

Of Counsel:

ROSEMARY NELSON, ESQ.
 YOUNG & RUBICAM INC.
 285 Madison Ave.
 New York, New York 10017
 (212) 210-3000



QUESTION PRESENTED

Is the tort of misappropriation of voice, recently recognized by the Ninth Circuit, preempted by Section 301 of the Copyright Act of 1976 because it creates liability for conduct expressly permitted by the Act, gives performers rights in copyrighted works which conflict and overlap with rights granted by the Act to the owners of copyrighted works, raises uncertainty as to the scope of preemption under the Act, and interferes with the uniform federal regulation of intellectual property rights by Congress?

PARTIES TO THE PROCEEDING

The parties before this Court are those set forth in the caption.¹

1/Pursuant to Supreme Court Rule 29.1, we advise the Court that Young & Rubicam Inc., a New York corporation with no United States subsidiaries, is general partner in Young & Rubicam L.P.

TABLE OF CONTENTS

	<u>Page</u>
Table of Authorities	vi
Opinions Below.	2
Jurisdiction.	4
Constitutional and Statutory Provisions Involved	5
STATEMENT OF THE CASE	6
The District Court Decision.	13
The Ninth Circuit Opinion.	14, 15
The Decision on Remand	16, 17
The Ninth Circuit Opinion.	18, 19
REASONS FOR GRANTING THE WRIT.	20
 <u>POINT I</u>	
THE TORT OF MISAPPROPRIATION OF VOICE IMPOSES LIABILITY FOR CONDUCT EXPLICITLY PERMITTED BY THE COPYRIGHT ACT.	22
 <u>POINT II</u>	
THE TORT OF MISAPPROPRIATION OF VOICE IS PREEMPTED BY SECTION 301 OF THE COPYRIGHT ACT OF 1976	27

POINT III

THIS CLAIM SHOULD BE PRE-EMPTED SINCE
IT INTERFERES WITH THE REGULATORY
SCHEME ESTABLISHED BY CONGRESS. . . . 36

POINT IV

THE RECENT OPINION OF THIS COURT IN BONITO BOATS ESTABLISHES THE PREEMPTIVE REACH OF ARTICLE 1 SECTION 8 42

POINT V

THE NINTH CIRCUIT'S OPINION ON IS IN
CONFFLICT WITH THE OPINIONS OF OTHER
CIRCUITS ON PREEMPTION 45

APPENDIX

Opinion of the United States Court of Appeals for the Ninth Circuit, September 20, 1991 (Affirming the grant of partial summary judgment to petitioner on the issue of punitive damages and affirming the order of the order of the District Court, which had been the subject of a cross appeal by petitioner) A-1

Decision of the United States District Court for the Central District of California (February 8, 1989) (Granting plaintiff's motion for partial summary judgment and granting defendants' motion for

partial summary judgment on the issue of punitive damages) . . .	A-15
Decision of the United States Court of Appeals for the Ninth Circuit (June 22, 1988) (Reversing District Court's order in part which granted summary judgment for defendants)	A-41
Decision of the United States District Court for the Central District of California (August 12, 1987) (Granting summary judgment for defendants on all claims, denying plaintiff's motion for summary judgment)	A-49
Decision of the United States Court of Appeals for the Ninth Circuit (August 26, 1988) (Denying defendant's request for rehearing en banc)	A-68
Copyright Act of 1976;	
17 U.S.C. §101	A-70
17 U.S.C. §102	A-71
17 U.S.C. §106	A-72
17 U.S.C. §114	A-73
17 U.S.C. §115	A-75
17 U.S.C. §301	A-77

TABLE OF AUTHORITIES

<u>CASES</u>	<u>Page</u>
<u>Baltimore Orioles, Inc. v.</u> <u>Major League Baseball Players</u> <u>Assoc.,</u> 805 F.2d 663 (7th Cir.	
1986), cert. denied, 480 U.S.	
941 (1987).....	21,46-47
<u>Bonito Boats, Inc. v. Thunder</u> <u>Craft Boats, Inc.,</u> 489 U.S.	
141	
(1989).....	17,42-45,50
<u>Davis v. Trans World Airlines,</u> 297 F. Supp. 1145 (C.D. Cal.	
1969).....	12
<u>Del Madera Properties v.</u> <u>Rhodes and Gardner, Inc.,</u> 820 F.2d 973 (9th Cir. 1987)....	28,33
<u>Harper & Row, Publisher's,</u> <u>Inc. v. Nation Enterprises,</u> 501 F. Supp. 848 (S.D.N.Y.	
1980) aff'd, 723 F.2d 195	
(2d Cir. 1983), rev'd on	
other grounds, 471 U.S.	
539 (1985).....	28,33
<u>Kelly v. Robinson,</u> 479 U.S. 36 (1986).....	38
<u>Mastro Plastics Corp. v.</u> <u>NLRB,</u> 350 U.S. 270 (1956).....	38

<u>Motown Record Corporation v. George A. Hormel & Co.,</u> 657 F. Supp. 1236 (C.D. Cal. 1987).....	33
<u>Offshore Logistics, Inc. v. Tallentire,</u> 477 U.S. 207 (1986).....	38
<u>Pilot Life Ins. v. Dedeaux,</u> 481 U.S. 41 (1987).....	38, 39
<u>Sinatra v. Goodyear Tire & Rubber Company,</u> 435 F.2d 711 (9th Cir. 1970), <u>cert. denied,</u> 402 U.S. 906 (1971).....	11
<u>Tin Pan Apple v. Miller Brewing Co., Inc.,</u> 737 F. Supp. 826 (S.D.N.Y. 1980).....	49
<u>United States v. Heirs of Boisdore,</u> 8 How. 113, 12 L. Ed. 1009 (1849).....	38
<u>United Steelworkers of America, AFC-CIO-CLC v. Rawsen,</u> 495 U.S. 362 (1990).....	39
<u>CONSTITUTIONAL PROVISIONS</u>	
<u>U.S. Constitution, Art. I, Sec. 8, Cl. 8.....</u>	5, 42

STATUTES

California Civil Code	
Sec. 1334.....	12
Copyright Act of 1976	
17 U.S.C. § 101	29
17 U.S.C. § 102	27, 28
17 U.S.C. § 106	24, 34
17 U.S.C. § 114	passim
17 U.S.C. § 115	35, 37, 50
17 U.S.C. § 301	passim
Employee Retirement Income Security Act of 1974, 29 U.S.C.	
\$1001, et seq.....	37, 38, 39
Federal Rule of Appellate Procedure 4(a)(2).....	
4	
Lanham Act, 15 U.S.C.	
§ 1125(a).....	13
Labor Management Relations Act, 29 U.S.C. §185.....	
39	
Public Law No. 92-140, 83 Stat. 391.....	
23	
28 U.S.C. § 1332.....	4
28 U.S.C. § 1254(1).....	5

CONGRESSIONAL SOURCES

120 Cong. Rec. 30399 (1974).....	24
H.R. 6063, 95th Cong., 1st Sess. (1977).....	26
H.R. 997, 96th Cong. 1st. 1st. Sess. (1979).....	26
H.R. Rep. No. 1476, 94th Cong., 2d Sess. (1976), reprinted in 1976 U.S. Code Cong. & Admin. News	
5659.....	7,19,32,37,48
<u>Performance Rights on Sound Recordings: Hearings before the Subcommittee on Courts Civil Liberties and the Administration of Justice of the House of Representatives Committee on the Judiciary, 95 Cong., 2d Sess. 83 (1978).....</u>	31
<u>Performance Rights in Sound Recordings, Report to Sub- committee on Courts, Civil Liberties, and the Admini- stration of Justice: Legis- lative History of Perform- ance Rights in Sound Recordings, 95th Cong., 2d Sess. Committee Print 15 (1978).....</u>	23,25

<u>Second Supplementary Report of the Registrar of Copy- rights on the General Revision of the U.S. Copy- right Law, 1975 Revision Bill, Chap. VIII (Oct.- Dec. 1975).....</u>	24
<u>Senate Report No. 72, 92nd Cong., 1st Sess. 4 (1971).....</u>	23
<u>S. 1361, Amendment No. 1846, 93rd Cong., 2d Sess. (1974).....</u>	24
<u>S. 597, Amendment No. 131, 90th Cong., 1st Sess. (1967).....</u>	23
<u>S. 1152, 96th Cong., 1st Sess. (1979).....</u>	26

No. 91-

IN THE
SUPREME COURT OF THE UNITED STATES
October Term, 1991

YOUNG & RUBICAM INC.,

Petitioner,

v.

BETTE MIDLER,

Respondent.

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

Young & Rubicam Inc., respectfully
prays that a writ of certiorari issue
to review the opinion of the United
States Court of Appeals for the Ninth
Circuit entered in this action on
September 20, 1991.

OPINIONS BELOW

There have been five opinions below in this matter:

1. Bette Midler v. Young & Rubicam Inc. (9th Cir. 1991) (September 20, 1991) (Hug J., Tang J., Noonan J.) (Memorandum and Order) (Affirming the grant of partial summary judgment to petitioner on the issue of punitive damages and affirming the order of the order of the District Court, which had been the subject of a cross appeal by petitioner). (reproduced herein at Appendix to the Petition at A1).

2. Bette Midler v. Young & Rubicam Inc. (February 8, 1989) (Fernandez, J.) (Granting plaintiff's motion for partial summary judgment and granting defendants' motion for partial summary judgment on the issue of

punitive damages) (reproduced at Appendix at A15).

3. Bette Midler v. Ford Motor Company and Young & Rubicam, 849 F.2d 460 (9th Cir. 1988) (June 22, 1988) (Hug. J., Tang, J. and Noonan, J., opinion by Noonan, J.) (Reversing District Court's order in part which granted summary judgment for defendants) (reproduced at Appendix at A41).

4. Bette Midler v. Ford Motor Company and Young & Rubicam, CV 86-2683 (C.D. Cal. 1987) (August 12, 1987) (Fernandez, J.) (Statement of Uncontroverted Facts and Conclusions of Law) (Granting summary judgment for defendants on all claims, denying plaintiff's motion for summary

judgment) (reproduced at Appendix at A49).

5. Bette Midler v. Ford Motor Company and Young & Rubicam (Hug J., Tang J., Noonan J.) (August 26, 1988) (Denying defendants' request for rehearing en banc) (reproduced at Appendix at A68).

STATEMENT OF JURISDICTION

This is an action for violation of state common law rights. The District Court had jurisdiction pursuant to 28 U.S.C. Section 1332, based on diversity of citizenship and claims exceeding \$10,000, exclusive of interest and costs. Following the entry of final judgment by the District Court on October 30, 1989, an appeal was filed by respondent on November 29, 1989,

pursuant to Federal Rule of Appellate Procedure 4(a)(2), and a cross-appeal was filed by petitioner on December 13, 1989. The Court of Appeals issued its order affirming the order appealed from on September 20, 1991. This petition for a writ of certiorari is being filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. Section 1254(1).

CONSTITUTIONAL AND
STATUTORY PROVISIONS INVOLVED

Article 1, Section 8, Clause 8 of the United States Constitution provides that:

The Congress shall have power ... to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

Copyright Act of 1976 ("Copyright Act"), 17 U.S.C. § 101 (1982) (App. A 70).²

17 U.S.C. § 102 (App. A71).

17 U.S.C. § 106 (App. A72).

17 U.S.C. § 114 (App. A73).

17 U.S.C. § 115 (App. A75).

17 U.S.C. § 301 (App. A77).

STATEMENT OF THE CASE

In the opinions below, the Ninth Circuit held that the deliberate imitation of a well known singer's distinctive voice creates liability under state tort law. The opinion for which certiorari is sought imposes liability under state common law for an activity expressly permitted by the federal Copyright Act. The Copyright Act provides

²/Citations to the Appendix to the Petition will be in the form App. A ____.

that exclusive rights in a sound recording "do not extend to the making or duplication of another sound recording that consists entirely of independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording." 17 U.S.C. Section 114(b). "Mere imitation of a recorded performance would not constitute copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible." Notes of Committee on the Judiciary, H.R. Rep. No. 1476, 94th Cong. 2d Sess. (1976), cited in 17 U.S.C.A. Section 114(b), Historical Note at 187 (1976).

In 1985 petitioner Young & Rubicam ("Y&R") began developing an advertising campaign for the Lincoln/Mercury divi-

sion of Ford Motor Company, using popular music from the 1960s and 1970s as background for the campaign's television commercials. (C.A. App. ER at 20-21.)³ Young & Rubicam entered into a contract with Bobby Freeman Music and Clockus Music Company for the right to "synchronize and record" "Do You Wanna Dance" for use in a television commercial over a six month period in 1986. (C.A. App. SER at 42-43.)

"Do You Wanna Dance" was written by Bobby Freeman, who first recorded the song in 1958. (C.A. App. SER at 16.) Since that time it has been recorded by at least eight other singers

3/Citations to the Appendix to the Petition will be in the form App. A __, see Footnote 1, supra. Citations to the Excerpt of Record and Supplemental Excerpts of Record before the Court of Appeals in Midler v. Young & Rubicam, (App. A __) will be in the form C.A. App. ER at __; and C.A. App. SER at __.

or singing groups, including plaintiff, who released a recording of the song in 1972 on an album entitled Bette Midler: The Divine Miss M. (C.A. App. SER at 16, 18-19.) Copyright in the sound recording of The Divine Miss M. was issued to Atlantic Recording Corporation on November 7, 1972. (C.A. App. SER at 52.)

In the spring of 1985, Craig Hazen, music producer for Y&R, contacted plaintiff's attorney and agent to discuss the possibility of employing plaintiff to record the background vocal for the version of "Do You Wanna Dance" to be used in the commercial. Midler's attorney indicated that his client would not be interested. (C.A. App. SER at 22-23.) Hazen then hired Ula Hedwig, a former back-up singer for

Midler. Hedwig sang the lead vocal and also one of the three background parts for the music in the commercial. (C.A. App. SER at 24-25.)

In creating the commercial Y&R intended to imitate the Divine Miss M. sound recording.

Plaintiff is never named in the commercial, nor is she identified in any other way by the commercial. The vocal track is anonymous and is not directly related to any of the visual images used in the commercial, which consist of shots of the automobile driving on a wet road interspersed with shots of a formally dressed couple. The woman in the commercial is tall, thin and dark haired, and bears absolutely no resemblance to plaintiff. There is nothing in the commercial to

suggest that Bette Midler or any other particular individual endorses the automobile depicted. (C.A. App. ER at 119.)

Y&R's use of "Do You Wanna Dance" in the sound track for the commercial was consistent with the prevailing law. In 1970 the Ninth Circuit Court of Appeals decided Sinatra v. Goodyear Tire & Rubber Company, 435 F.2d 711 (9th Cir. 1970), cert. denied, 402 U.S. 906 (1971), holding that Y&R had not violated any rights of Nancy Sinatra when it produced a television commercial with a sound track which featured an imitation of Nancy Sinatra's recording of a song entitled "These Boots Are Made For Walkin," and which featured a model who looked and was dressed like Nancy Sinatra. In Sinatra, the Ninth

Circuit cited Davis v. Trans World Airlines, 297 F. Supp. 1145 (C.D. Cal. 1969), which also held that a commercial using an imitation of a well-known singing group's performance of a popular song did not violate any rights under California law.

The commercial was first broadcast nationally in January, 1986, and ran until June of that year.

This action was commenced on April 29, 1986. Plaintiff filed an amended complaint on May 23, 1986 (hereinafter referred to as the "complaint"). (C.A. App. ER at 229.) Plaintiff's complaint stated four substantive causes of action: violation of California Civil Code Section 3344; violation of plaintiff's right of privacy; violation of plaintiff's right of publicity; and

unfair competition. (C.A. App. ER at 3-9.) On May 18, 1987, after discovery had closed, the trial court denied Midler's motion to further amend her complaint to add a cause of action under Section 43(a) of the Lanham Act, 15 U.S.C. Section 1125(a). (C.A. App. ER at 229.) Cross-motions for summary judgment by petitioner Young & Rubicam and Ford Motor Company ("Ford") and by plaintiff were heard before the District Court on July 13, 1987. (C.A. App. ER at 229.) In a Statement of Uncontroverted Facts and Conclusions of Law dated August 12, 1987, the District Court granted the motion for summary judgment of petitioner Y&R and Ford and denied Midler's motion for summary judgment. (App. A49.) Midler appealed from the grant of summary judgment to

defendants, the denial of her own motion for summary judgment, and the denial of her motion to amend her complaint. (App. A41.)

On June 22, 1988, the Ninth Circuit reversed only that part of the District Court's order which granted petitioner's motion for summary judgment. Midler v. Ford Motor Company, 849 F.2d 460 (9th Cir. 1988) (App. A41.) ("Midler I"). After rejecting plaintiff's claims under Cal. Civ. Code Section 3344 and the common law of unfair competition and invasion of privacy, the Ninth Circuit reviewed the extant case authority and concluded that a cause of action for the appropriation of another's voice, based on the right of publicity, does exist in California.

We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort.

(App. A48.) The Ninth Circuit held that Midler "ha[d] made a showing sufficient to defeat summary judgment" on her cause of action for violation of her right of publicity and remanded the case for trial. (App. A48.)

On January 9, 1989, the District Court granted defendant's motion for summary judgment dismissing plaintiff's claim for punitive damages. Plaintiff's motion for reconsideration was denied on September 25, 1989 following transfer of the case to Judge Tashima.

(C.A. App. ER at 229.)

The jury trial of this action commenced on October 24, 1989. (C.A. App. ER at 229.) Only one fact was in dispute: whether Young & Rubicam intended to imitate Midler's voice when it created the television commercial. The evidence was largely uncontradicted and demonstrated that the petitioner intended to imitate the 1972 sound recording of "Do You Want To Dance."

At the conclusion of the evidence relating to liability, petitioner Young & Rubicam moved for a directed verdict on the ground that the only evidence presented to the jury proved that Y&R attempted to imitate the recorded version of the song "Do You Want To Dance" and that there was absolutely no evidence to support the contention that Y&R intended to imitate the sound of

plaintiff's voice separate and apart from the sound recording. (C.A. App. SER at 115-16.) The Trial Court denied petitioner's motion for a directed verdict. (C.A. App. SER at 116.) On October 30th the jury returned a verdict in Midler's favor in the amount of \$400,000. (C.A. App. ER at 224.)

On November 29, 1989, Midler filed a notice of appeal from the Trial Court's order granting defendant's motion for partial summary judgment as to plaintiff's claim for punitive damages. (C.R. App. ER at 226). On December 13, 1989, Y&R filed its notice of cross-appeal. (C.A. App. SER at 123.)

Petitioner's cross-appeal argued that Midler's claim was preempted by Section 301 of the Copyright Act and that the Court should reconsider its

decision in Midler I, based on the Supreme Court's opinion in Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989), which clearly established the preemptive reach of Article 1, Section 8 of the Constitution.

On September 20, 1991, the Court of Appeals affirmed the order appealed from with respect to the issue of punitive damages. (App. A5-7) (citation omitted).

The Ninth Circuit also denied petitioner's cross-appeal. The Court of Appeals stated "Section 301(b) makes clear that any state regulation that does not fit precisely within the scope of Section 301(a) is not preempted." Furthermore, the legislative history of Section 301 indicates that Congress

understood that "[t]he evolving common law rights of 'privacy,' 'publicity,' and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or breach of trust or confidentiality, that are different in kind from copyright infringement." (App. A12.) H.R. Rep. No. 1476, 94th Cong., 2d Sess., reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5748. The Court went on to hold that the law of the case controlled and the previous opinion would stand. (App. A13.)

REASONS FOR GRANTING THE WRIT

The tort outlined by the Ninth Circuit creates liability under state law for conduct expressly permitted by a federal statute which purports to preempt equivalent statelaw rights. By recognizing liability for the tort of "misappropriation of voice," the Ninth Circuit has enervated the intended preemptive effect of Section 301 of the Copyright Act, calling into question the scope of federal regulation of intellectual property rights. The tort outlined by the Ninth Circuit creates liability under California law for conduct expressly permitted by the explicit language of Section 114(b) of the Copyright Act. Similarly, the enforcement of a performer's rights under the new tort interferes with the compulsory

licensing scheme set out in Section 115 of the Copyright Act.

The Ninth Circuit's opinion also conflicts with the Seventh Circuit's interpretation of the preemptive reach of Section 301 of the Copyright Act, Baltimore Orioles, Inc. v. Major League Baseball Players Assoc., 805 F.2d 663 (7th Cir. 1986), cert. denied, 480 U.S. 941 (1987).

The Copyright Act represents Congress' attempt to balance the rights of performers and composers. The opinion of the Ninth Circuit creates confusion as to the scope and reach of that statutory scheme and raises serious issues worthy of the Court's plenary review.

POINT I

THE TORT OF MISAPPROPRIATION
OF VOICE IMPOSES LIABILITY FOR
CONDUCT EXPLICITLY PERMITTED BY
THE COPYRIGHT ACT

In Midler I, the Ninth Circuit articulated the elements of "misappropriation of voice": (1) the distinctive voice, (2) of a professional singer, (3) who is widely known, (4) is deliberately imitated, (5) in order to sell a product. (App. A48.) At trial, plaintiff presented no evidence that defendant attempted to imitate the sound of her voice apart from the version of "Do You Wanna Dance" which she popularized which fixed on the Divine Miss M album. Thus, the cause of action articulated in Midler I subjects defendant to liability solely for doing what Section 114 permits, i.e., deliber-

ately imitating the sound recording of "another's performance as exactly as possible." There is no provision in the Copyright Act which prohibits imitation under Section 114 when it is for commercial uses.

The events preceding the passage of the Copyright Act indicate that Congress was cognizant of the fact that Section 114(b) as written abrogated any performance rights in sound recordings.⁴ "The new statute expressly

⁴/Congress first provided copyright protection for sound recordings in 1972, with the passage of Public Law No. 92-140, 83 Stat. 391. Prior to this, numerous bills had been introduced which would have provided a performance right in sound recordings. See S. 597, Amendment No. 131, 90th Cong. 1st Sess. (1967), introduced by Senator Williamson, also see Performance Rights in Sound Recordings, Report to Subcommittee on Courts, Civil Liberties, and the Administration of Justice: Legislative History of Performance Rights in Sound Recordings, at 45, 95th Cong., 2d Sess. Committee Print 15 (1978). However, performance rights were left out of the final

excludes performance rights to sound recordings. Instead, it requests the Registrar of Copyrights to study the problem and, after consultation with various interested groups, report on whether Federal copyright legislation

version of the law. Senate Report No. 72, 92nd Cong., 1st Sess. 4 (1971).

Performance rights for sound recordings were again thoroughly debated, before the passage of the 1976 Copyright Act. On September 5, 1974, by a vote of 67 to 8, Congress passed an amendment to the then current copyright revision bill which specifically removed performance rights. 120 Cong. Rec. 30399 (1974). This amendment provided: "the exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1) and (3) of Section 106, and do not include any right of performance under Section 106(4). See S.1361, amendment No. 1846, 93rd Cong., 2d Sess. (1974). Congress also commissioned a report from the Registrar of Copyright on the subject of performance rights in sound recordings. Second Supplementary Report of the Registrar of Copyrights on the General Revision of the U.S. Copyright Law; 1975 Revision Bill, Chap. VIII (Oct.-Dec. 1975). The report concluded performance rights were constitutional, and that it was a Congressional policy decision whether to enact them. Supplementary Report at 27. The final version of the bill passed, which became the Copyright Act, deliberately excluded performance rights.

providing performance rights for sound recordings should be enacted." Letter of Transmittal, Registrant's Report to Subcommittee on Performance Rights. See Copyright Act, 17 U.S.C. Section 114(d).

Following the submission of the report by the Registrar on January 3, 1978, Congress again held several hearings on performance rights. Performance Rights on Sound Recordings: Hearings before the Subcommittee on Courts, Civil Liberties, and the Administration of Justice of the House of Representa-

tives Committee on the Judiciary, 95 Cong., 2d Sess. 83 (1978).⁵

The commission of this report and Congress's failure to enact legislation which modified the language in Section 114(b) indicate that Congress considered and rejected amending the Copyright Act to protect performance rights in sound recordings.

5/Two bills resulted from these hearings which proposed amending the Copyright Act to create a performance right: the Danielson Bill, H.R. 6063, 95th Cong., 1st Sess. 1977, later revised and presented to the House Committee on the Judiciary as H.R. 997, 96th Cong. 1st Sess., and the Williamson Bill, S. 1152, 96th Cong. 1st Sess., (1979). Both bills were presented to the respective Committees on the Judiciary, but never went to the full House or Senate.

ARGUMENTPOINT II

THE TORT OF MISAPPROPRIATION OF VOICE
IS PREEMPTED BY SECTION 301 OF
THE COPYRIGHT ACT OF 1976

The tort of misappropriation of voice is "qualitatively equivalent" to the exclusive rights within the scope of copyright because it creates rights in a sound recording which overlap with and expand exclusive rights granted under the Copyright Act, and it should thus be preempted by Section 301 of the Act.

Preemption under Section 301 of the Act depends on two conditions. First, the work in which rights are asserted "must come within the 'subject matter of copyright' as defined in Sections 102 and 103 of the Copyright Act. Second the rights granted under state

law must be 'equivalent to any of the exclusive rights within the general scope of Copyright as specified by Section 106" Del Madera Properties v. Rhodes and Gardner, Inc., 820 F.2d 973, 976 (9th Cir. 1987), quoting Harper & Row, Publishers, Inc. v. Nation Enterprises, 501 F. Supp. 848, 850 (S.D.N.Y. 1980), aff'd, 723 F.2d 195 (2d Cir. 1983), rev'd on other grounds, 471 U.S. 539 (1985).

In Midler I the Ninth Circuit held that Midler's right of publicity is not preempted by the Copyright Act because the "work" in which the right of publicity is asserted (Midler's voice) is not fixed in a tangible form and, therefore, does not come within the subject matter of the copyright laws.

Petitioner respectfully submits that the holding of Midler I was clearly erroneous because it overlooked the effect of Midler's sound recording of "Do You Want To Dance" on the common law right asserted by her. A sound recording, including the version of "Do You Wanna Dance" contained on the Divine Miss M. album, is a work of authorship fixed in a tangible form within the meaning of Section 301 of the Act and encompasses each of the sounds in that sound recording, including the sound of the singer's voice. See 17 U.S.C. Section 101. The Ninth Circuit's conclusion that a singer's voice can never be fixed because it is "too personal" essentially exempts singers, and the copyrightable works they create with their voices, from the

operation of Section 114(b) of the Act, which limits the scope of exclusive rights in sound recordings.

In her testimony before the Senate Subcommittee in 1978 following the issuance of the Report on Performance Rights, the Registrar of Copyrights, Barbara Ringer, rejected the reasoning that sound recordings could be treated as fixed work for some purposes and not for others.

a. Issue. - Are sound recordings "the writings of an author" within the meaning of the Constitution?

Conclusion: Yes.

Discussion: Arguments that sound recordings are not "writings" and that performers and record producers are not "authors" have become untenable. The courts have consistently upheld the constitutional eligibility of sound recordings for protection under the copyright law. Passage of the 1971 Sound Recording Amendment was a

legislative declaration of this principle, which was reaffirmed in the Copyright Act of 1976.

b. Issue. - Can sound recordings be "the writings of an author" for purposes of protection against unauthorized duplication (piracy or counterfeiting), but not for purposes of protection against unauthorized public performance?

Conclusion: No.

Discussion: Either a work is the "writing of an author" or it is not. If it is, the Constitution empowers Congress to grant it any protection that is considered justified. There is no basis, in logic or precedent, for suggesting that a work is a "writing" for some purposes and not for others.

Performance Rights: Hearings Before Subcommittee, Testimony of B. Ringer at 117 (1978).

There is no principled basis for distinguishing the vocal component of a sound recording from any other audible element; the entire performance on the sound recording can be imitated under

Section 114(b), including the vocal components. Since a voice on a sound recording is part of a work of fixed authorship, the state law rights recognized in Midler I are subject to preemption under Section 301.

The second element of preemption under Section 301 is met if the state law cause of action creates rights that are qualitatively equivalent to any of the exclusive rights within the general scope of copyright. "All corresponding state laws, whether common law or statutory, are preempted and abrogated under Section 301." Notes of Committee on the Judiciary, H.R. Rep. No. 1476, cited in 17 U.S.C.A. Section 301, Historical Note at 271 (1977). A state law right corresponds to the exclusive rights under copyright if the state law

right is infringed by the act of reproduction, performance, distribution or display without requiring any additional element which would "change the nature of" the state law action and make it "qualitatively different from" a copyright infringement claim. Del Madera, 820 F.2d at 977; Motown Record Corporation v. George A. Hormel & Co., 657 F. Supp. 1236, 1239 (C.D. Cal. 1987). The additional elements of the cause of action articulated by the panel do not preserve it from preemption under Section 301 of the Act because they merely alter the scope of the cause of action. Harper & Row Publishers, Inc. v. Nation Enterprises, 720 F.2d 195 (2d Cir. 1983), rev'd on other grounds, 471 U.S. 539 (1985); see Del Madera Properties v. Rhodes and

Gardner, Inc., 820 F.2d at 973 (9th Cir. 1987).

The tort of misappropriation of voice also grants Midler broader rights than either the copyright owner of the song or the owner of the copyright in the sound recording. The exclusive rights granted to the owner of a copyright in a musical work, such as the composition "Do You Wanna Dance," are set forth in Section 106 of the Act and include the right to reproduce the copyrighted work and prepare derivative works based on the copyrighted work. The rights of a copyright owner in a sound recording are further limited by Section 114(b), which specifically includes any rights regarding imitation of the work. Midler merely obtained a license to record a version of "Do You

"Wanna Dance" by following the compulsory licensing scheme of Section 115 of the Copyright Act. Under the tort recognized by the Ninth Circuit, Midler recovered damages for the imitation of her version of "Do You Wanna Dance." Neither the owner of the copyright in the song or the owner of the copyright in the sound recording would have been permitted to recover for this conduct under the Copyright Act.

Thus, rights recognized by the Ninth Circuit in Midler I are "qualitatively equivalent" to the exclusive rights within the scope of copyright in two respects: they overlap and expand on the exclusive rights granted under the Copyright Act, in addition to limiting the exclusive rights in a musical work in such a way as to prohibit activ-

ties specifically allowed under the Copyright Act.

POINT III

THIS CLAIM SHOULD BE PRE-EMPTED SINCE IT INTERFERES WITH THE REGULATORY SCHEME ESTABLISHED BY CONGRESS

In holding that Congress did not intend to pre-empt a claim for misappropriation of voice contained on a sound recording, the Court of Appeals quotes Section 301: "the legislative history of Section 301 indicates that Congress understood that "[t]he evolving common law rights of 'privacy,' 'publicity,' and trade secrets and the general laws of defamation and fraud would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are

different in kind from copyright infringements." H.R. Rep. No. 1476,⁶ cited in 17 U.S.C.A. Section 301, Historical Note at 272.

The Court's reference to the legislative intent of Section 301 ignores the fact that Congress has enacted a comprehensive legislative scheme which includes an exclusive licensing system set out in Section 115 of the Copyright Act. As this Court noted when examining the Employee Benefits and Retirement Savings Act, 29 U.S.C. Section 1001, et seq., ("ERISA"), when a

⁶/However, this report goes on to state:

The declaration of this principle [of preemption] in §301 is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its message that Congress shall act preemptually, and to avoid the development of any vague borderline areas between State and Federal protection. Id.

"savings clause" under a comprehensive federal law is examined, the entire scheme of the statute must be considered: "'in expounding a statute, we must not be guided by a single sentence or member of a sentence, but look to the provision of the whole law, and to its object and policy.'" Pilot Life Ins. v. Dedeaux, 481 U.S. 41, 51 (1987), quoting Kelly v. Robinson, 479 U.S. 36, 43 (1986), quoting Offshore Logistics, Inc. v. Tallentire, 477 U.S. 207, 221 (1986) (quoting Mastro Plastics Corp. v. NLRB, 350 U.S. 270, 285 (1956) (in turn quoting United States v. Heirs of Boisdore, 8 How. 113, 122, 12 L.Ed. 1009 (1849))).

Pilot Life Insurance provides that where, as here, Congress by its actions indicates an intent to omit a remedy as

part of a comprehensive regulatory scheme "the policy choice reflected in the inclusion of certain remedies and the exclusion of others under the federal scheme would be completely undermined if .. [parties] were free to obtain remedies under state law that Congress rejected...". Pilot Life, 481 U.S. 54. Under ERISA, and under the Labor Management Relations Act, 61 Stat. 156, 29 U.S.C. Section 185) ("LMRA"), the Court has found that intent to omit in the detailed enforcement scheme set out in those statutes.

See United Steelworkers of America, AFL-CIO-CLC v. Rawson, 495 U.S. 362 (1990) (preemption by federal labor law governing collective bargaining agreements not avoided by characterizing union's acts as a state-law tort).

In the Copyright Act, the intent to omit is found not only in the licensing scheme, which establishes the rights of the copyright owner, but also in the express language of Section 114(b). This conclusion is further enforced by Congress's subsequent consideration and rejection of attempts to amend the Act to provide such a remedy to performers. It is anomalous to state that prior history and specific language do not preclude the creation of a tort when those rights were clear-

ly considered and rejected by Congress.⁷

7/As the sheer volume of literature on the subject indicates, the right created by the Ninth Circuit was previously unrecognized, and has remained unique. A short list of the more recent articles discussing Midler includes: Wohl, Federal Preemption of the Right of Publicity in Sing-Alike Cases, 1 Fordham Ent. Media & Intell. Prop. L.F. 47 (1990); Note, "Do You Want To Dance" Around the Law? Learn the Latest Steps from the Ninth Circuit in Midler v. Ford Motor Company, 23 Loy. L.A.L. Rev. 601 (1990); Karlin, A Rose By Another Voice? Commercial Voice Misappropriation In Midler v. Ford Motor Company, 19 Sw. U.L. Rev. 1137 (1990); Note, Tuning Up the Copyright Act: Substantial Similarity and Sound Recording Protections, 73 Minn. L. Rev. 1175 (1989); Note, Whose Voice is it Anyway? Midler v. Ford Motor Co., 8 Cardozo Arts & Ent. L.J. 201 (1989); Note, Advertisers Beware: Bette Midler Doesn't Want to Dance, 9 Loy. Ent. L.J. 43 (1989); Note, Voicing Concern: An Overview of the Current Law Protecting Singers' Voices, 40 Syracuse L. Rev. 1255 (1989); Wohl, The Right of Publicity and Vocal Larceny: Sounding Off On Sound-Aliques, LVII Fordham L. Rev. 445 (1988).

POINT IV

THE RECENT OPINION OF THIS COURT IN
BONITO BOATS ESTABLISHES THE PREEMPTIVE
REACH OF ARTICLE 1 SECTION 8.

In Bonito Boats this Court recently explained the preemptive force of Article 1, Section 8 of the United States Constitution, which empowers Congress to grant patents and copyrights. Bonito Boats held that federal law preempted a Florida statute making it unlawful to use the direct molding process to duplicate an unpatented boat hull. Although Bonito Boats was decided in the context of the patent laws, it is directly relevant to the state law right at issue here in three respects.

First, it reaffirmed that "state regulation of intellectual property must yield to the extent that it

clashes with the balance struck by Congress in our patent laws Where it is clear how the patent laws strike that balance in a particular circumstance, that is not a judgment the States may second guess." 489 U.S. at 152. In the Copyright Act Congress has struck a balance between the rights of composers and performers and has determined that performers may not prohibit others from intentionally imitating their sound recordings. The state law right recognized in Midler I directly upsets this balance.

Second, where a state law is not directed at the protection of consumers from "confusion as to source," the state's ability to impede the use by the public of intellectual property not protected by federal law is extremely

limited. 489 U.S. at 158. Midler I held that unfair competition was not an issue in the case. The trial court was not presented with any evidence of consumer confusion. The right recognized in Midler I, therefore, cannot interfere with the public's right to make use of materials not protected by copyright, including the sound recording of "Do You Want To Dance."

Third, the Court recognized in Bonito Boats that the states are not free to protect "ideas which Congress has determined should belong to all." 489 U.S. at 164. Federal patent law creates a right to use those ideas which it does not protect. Id. The Florida statute in Bonito Boats impermissibly interfered with that right

even though it only prohibited one method of copying unpatented boat hulls. Section 114(b) of the Copyright Act expressly recognizes a right to imitate a sound recording. Whether Midler's voice is "more personal than any work of authorship," a state law right prohibiting the imitation of her voice obviously impacts on the public's right under Section 114(b) to imitate sound recordings featuring that voice. Therefore, Bonito Boats mandates the preemption of the state right recognized in Midler I.

POINT V

THE NINTH CIRCUIT'S OPINION IS IN CONFLICT WITH THE OPINIONS OF OTHER CIRCUITS ON PREEMPTION

The conclusion that Midler was asserting rights in sounds that are not

fixed conflicts with the Seventh Circuit's holding in Baltimore Orioles v. Major League Baseball Players, 805 F.2d at 663. In Baltimore Orioles, major league baseball players claimed a state law right of publicity in their performances in certain baseball games; the copyrights in the telecast of those games were owned by the baseball team franchises. The Seventh Circuit rejected the players' claim that broadcast of the games infringed their right of publicity:

The players' performances are embodied in a copy, viz, the videotape of the telecast, from which the performances can be perceived, reproduced, and otherwise communicated indefinitely. Hence their performances are fixed in tangible form, and any property rights in the performances that are equiva-

lent to any of the rights encompassed in a copyright are pre-empted.

Id. at 675.

Midler I did not distinguish or discuss Baltimore Orioles, although the import of that opinion is clear: once a performance is reduced to a fixed form the performer's state-created publicity rights in that performance are preempted by the Copyright Act. It is immaterial that Midler may have performed "Do You Wanna Dance" a number of times when it was not recorded.

In the House Report on the Copyright Act, Congress provided examples of works of authorship which were not fixed in any tangible medium of expression, including "choreography that has never been filmed or notated, an extemporaneous speech, 'original works of

authorship' communicated solely through conversations or live broadcast, and a dramatic sketch or musical composition improvised or developed from memory and without being recorded or written down."

H.R. Rep. 1476, cited in 17 U.S.C.A. Section 301 at 272 (emphasis added). Works of authorship that have never been fixed in a tangible medium of expression have no equivalent copyrightable fixed work. Once the dance has been filmed or the musical improvisation recorded, the work is fixed and equivalent common law rights are preempted. Performing the dance again or playing the composition from memory does not resurrect the preempted common law rights because the fixed work still exists and still gives rise to equivalent copyrights. Similarly, the fact

that Midler has performed "Do You Wanna Dance" live, or the fact that she has performed other songs with her voice, does not revive the common law rights in her recorded version of "Do You Wanna Dance." Midler's state law rights in that performance have been replaced by statutorily defined copyrights.⁸

CONCLUSION

The tort of misappropriation of voice creates liability for conduct expressly permitted by the Copyright Act of 1976. Midler I permits California singers to reap the benefits of the compulsory licenses granted by Sec-

8/Outside of California, Courts have declined to follow the Ninth Circuit's lead and expand the rights of privacy and publicity to include a claim for "sound-alikes." See Tin Pan Apple v. Miller Brewing Co., Inc., 737 F.Supp. 826, 838 (S.D.N.Y. 1990).

tion 115 of the Copyright Act -- as Midler did when she recorded "Do You Wanna Dance" without the express permission of the copyright owners -- while avoiding the corresponding limitations on performers' rights contained in Section 114 of the Act. See Bonito Boats, 489 U.S. 152 ("Where the public has paid the congressionally mandated price for disclosure, the States may not render the exchange fruitless by offering patent-like protection to the subject matter of the expired patent.") See Bonito Boats, 489 U.S. 162 (national uniformity is a fundamental purpose of the Copyright Clause). Every artist who has performed a song which she has also recorded could, under the concept of "fixed" expressed in Midler I, assert state-created rights against

those who subsequently imitate the song simply by claiming that she is asserting rights in the sound of her voice and not in the sound recording containing her performance of the song. The determination in Midler I that the asserted state law rights are not preempted conflicts with the uniform application of the Copyright Act.

While Congress limited the preemptive force of Section 301 to works that had been "fixed in any tangible medium of expression," it could not have intended to provide thereby an alternative cause of action to plaintiffs involved in performance-related activities. Such a proliferation of state-created rights would be inconsistent with Congress' express intent to act preemptively through Section 301 of the

Copyright Act and would destroy the national uniformity of rights currently enforced by the Copyright Act.

Dated: New York, New York

December 18, 1991

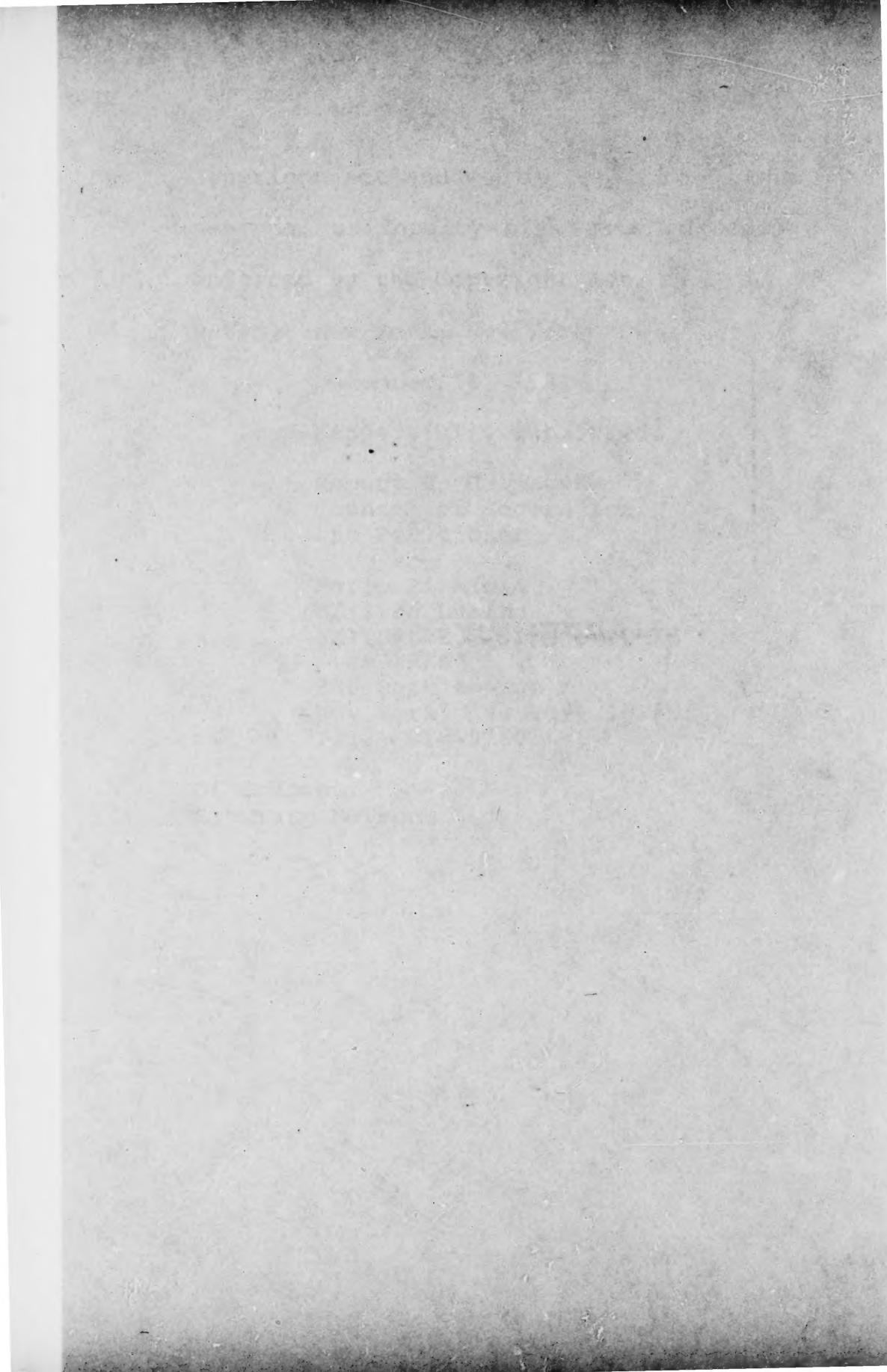
Respectfully submitted,

Robert M. Callagy
Counsel of Record for
the Petitioner

Mario A. Aieta
Gillian Lusins
SATTERLEE STEPHENS BURKE
& BURKE
230 Park Avenue
New York, New York 10169
(212) 818-9200

Of Counsel:
Rosemary Nelson

APPENDIX



A-1

NOT FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

BETTE MIDLER,

Plaintiff-Appellant/
Cross-Appellee,

v.

YOUNG & RUBICAM INC.,

Defendant-Appellee/
Cross-Appellant.

Nos. 90-55027,
90-55028

DC# CV 86-2683-AWT

* This disposition is not appropriate for publication and may not be cited to or by the courts of this circuit except as provided by Ninth Cir. R. 36-3.

** The panel finds this case appropriate for submission without oral argument pursuant to Fed. R. App. P. 34(a) and Ninth Cir. R. 34-4.

MEMORANDUM*

Appeal from the United States
District Court for the
Central District of California
A. Wallace Tashima,
District Judge, Presiding

Submitted July 16, 1991**

Before: HUG, TANG and NOONAN,
Circuit Judges

The facts of this case are set forth in detail in our decision in Midler v. Ford Motor Co., 849 F.2d 460 (9th Cir. 1988) (hereinafter Midler I). In brief, Bette Midler filed a complaint on April 29, 1986 after advertising agency Young & Rubicam Inc. created a television commercial using a Midler sound-alike. On July 20, 1987 the district court granted defendant's motion for summary judgment on the ground that Midler had no protectible rights under

the laws of California. We reversed the district court holding that "when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California." Midler I, 849 F.2d at 463. We remanded the case for trial.

Both Midler and Young & Rubicam brought motions for partial summary judgment. The district judge granted defendant's motion for partial summary judgment with respect to the issue of Midler's right to pursue punitive damages at trial holding that Midler had not "shown by clear and convincing evidence that the Defendants acted with

the requisite 'evil motive' to support an award of punitive damages." The district granted summary judgment for Midler on all the elements of the tort except deliberate imitation of Midler's voice, causation, and damages.

A jury trial on the action was conducted. At the conclusion of all the evidence relating to liability, Young & Rubicam moved for a directed verdict on the ground that there was no evidence to support Midler's contention that Young & Rubicam intended to imitate the sound of Midler's voice separate and apart from the "Do You Want to Dance" sound recording. The court denied the motion. On October 30, 1989, the jury returned a verdict for Midler and awarded \$400,000 in damages.

On November 29, 1989, Midler filed a notice of appeal from the trial court's grant of summary judgment on the issue of punitive damages. On December 13, 1989, Young & Rubicam cross-appealed on the grounds that the district court improperly denied its motion for a directed verdict, that the jury instructions were prejudicial and that Midler's claim should have been preempted by federal copyright law.

ANALYSIS

1. Punitive Damages.

The district court correctly concluded that Midler could not show by clear and convincing evidence that Young & Rubicam acted with the requisite "evil motive" to support a grant

of punitive damages under California law. California Civil Code § 3294 allows the award of punitive damages where the defendant has been guilty of "oppression, fraud, or malice." Cal. Civ. Code § 3294(a) (West's Supp. 1991). Malice is defined as "conduct which is intended by the defendant to cause injury to the plaintiff or despicable conduct which is carried on by the defendant with a willful and conscious disregard for the rights or safety of others." Cal. Civ. Code § 3294(c)(1) (West's 1991). In the present case the district court found that there was no evidence presented which suggested that in making the commercial Young & Rubicam intended to hurt Midler. The district court also found that Midler

could not show that Young & Rubicam acted with malice "since the tort in question has only recently been discovered." See e.g. Morgan Guar. Trust Co. v. American Sav. and Loan, 804 F.2d 1487, 1500 (9th Cir. 1986) (holding that punitive damages are inappropriate under California law where key issue is one of first impression), cert. denied, 482 U.S. 929 (1987); Bartling v. Glendale Adventist Medical Center, 184 Cal.App.3d 961, 970, 229 Cal. Rptr. 360, 364 (1986) (affirming the denial of punitive damages where plaintiffs rights were not legally established or clearly developed at the time of the violation).

2. Jury Instructions.

The district court instructed the jury that it must determine "[w]hether Young & Rubicam deliberately imitated Bette Midler's voice in producing Ford Motor Company's Sable automobile television commercial" The court also instructed:

Most of you are familiar with the term "copyright." Copyright law protects authors of original works, such as the song "Do You Want to Dance." There are no issues of copyright law, as such, for you to decide in this case. However, in deciding whether or not Young & Rubicam deliberately imitated Bette Midler's voice, you must keep in mind that Young & Rubicam had the right to use the song "Do You Want to Dance." You must also keep in mind that the mere imitation of a performance contained in a recording is not a violation of the Copyright law.

The instructions adequately set forth the law as laid out in Midler I. Nothing in our initial decision suggested

that Midler would have to prove that Young & Rubicam imitated Midler's voice "separate and apart" from the sound recording of "Do You Want to Dance."

3. Denial of defendant's motion for a directed verdict.

Young & Rubicam appeal the district court's denial of its motion for a directed verdict on the ground that Midler failed to present evidence that Young & Rubicam attempted to imitate Midler's voice. However, sufficient evidence was presented to support the jury's finding that Young & Rubicam deliberately imitated Midler's voice. The jury listened to the commercial and to Midler's recording of "Do You Want to Dance." The similarity of the

voices on the two recordings was evidence considered by the jury. The fact that Young & Rubicam hired a former Midler backup singer also supports an inference that the agency deliberately imitated Midler's voice. The testimony at trial, especially that of Hedwig, further supported the jury's verdict. For instance, Hedwig testified that she was contacted by a Young & Rubicam employee "about sending an audio cassette of myself sounding like Bette Midler as a sort of audition tape for this upcoming jingle." (Tr. 10/25/89 a.m. session pp. 92-93). She also testified that she was instructed to sound as much like Midler as possible while making the recording. Thus, the evidence at trial supported the finding that

Young & Rubicam sought "to convey the impression that Midler was singing for them," Midler I, 849 F.2d at 463, and that Young & Rubicam sought to imitate Midler's voice, an attribute of her identity.

4. Preemption.

This court in Midler I held that Midler's claim for appropriation of her voice was not preempted by federal copyright law. Id. at 462. Section 301(a) of 17 U.S.C. preempts:

all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103.

Section 301(b) makes clear that any state regulation that does not fit precisely within the scope of section 301(a) is not preempted. Furthermore, the legislative history of Section 301 indicates that Congress understood that "[t]he evolving common law rights of 'privacy,' 'publicity,' and trade secrets, and the general laws of defamation and fraud, would remain unaffected as long as the causes of action contain elements, such as an invasion of personal rights or a breach of trust or confidentiality, that are different in kind from copyright infringement."

H.R. Rep. No. 1476, 94th Cong., 2d Sess., reprinted in 1976 U.S. Code Cong. & Admin. News 5659, 5748.

In holding that Midler's cause of action was not preempted by federal copyright law this court said:

Copyright protects 'original works of authorship fixed in any tangible medium of expression.' 17 U.S.C. § 102(a). A voice is not copyrightable. The sounds are not 'fixed.' What is put forward as protectible here is more personal than any work of authorship.

849 F.2d at 462. Where a court has previously decided an issue, the law of the case controls "unless the first decision is clearly erroneous and would result in manifest injustice, an intervening change in the law has occurred, or the evidence on remand is substantially different. Eichman v. Fotomat Corp., 880 F.2d 149, 157 (9th Cir. 1989); see also Waggoner v. Dallaire, 767 F.2d 589, 593 (9th Cir. 1985), cert. denied, 475 U.S. 1064 (1986).

Young & Rubicam has not satisfied any of these three exceptions to the law of the case doctrine.

Accordingly, the judgment of the district court is AFFIRMED.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

BETTE MIDLER,

Plaintiff,

v.

FORD MOTOR COMPANY, et al.,

Defendants.

No. CV 86-2683 FFF (Gx)

STATEMENT OF UNCONTROVERTED
FACTS AND CONCLUSIONS OF LAW

This matter came on for hearing on January 9, 1989, on motions for summary judgment filed by Plaintiff Bette Midler, and for partial summary judgment filed by Defendants Ford Motor Company and Young & Rubicam, Inc. Peter Laird appeared on behalf of Plaintiff. Robert M. Callagy and Howard J.

Privett appeared on behalf of Defendants.

The Court has considered the papers, evidence and argument of the parties and hereby enters the following statement of uncontroverted facts and conclusions of law.

STATEMENT OF UNCONTROVERTED FACTS

1. Plaintiff Bette Midler ("Midler"), a citizen of California, is a well-known recording artist, concert performer, comedienne and motion picture actress.

2. Defendant Ford Motor Company ("Ford") is a Delaware corporation with its principal place of business in the state of Michigan. Ford is engaged in

the manufacture, advertising, and sale of motor vehicles and other products.

3. Defendant Young & Rubicam ("Y&R") is a New York corporation with its principal place of business in New York. Y&R is an advertising agency and has Ford as one of its clients.

4. Midler's first record album, "Bette Midler -- The Divine Miss M", was released in 1972. The first song on side one of the album is "Do You Want to Dance". (Hereinafter the song is sometimes referred to as the "composition".) A 45-rpm single version of the Midler Record was also released. It received extensive radio air-play, and was on the Billboard singles chart and other music trade charts. Midler regularly performed the composition on

concert tours for more than a decade. One such live concert performance was recorded, and the composition was again released by Midler in 1977 on a phonograph album entitled "Bette Midler, Live At Last".

5. Bobby Freeman wrote "Do You Wanna Dance" in 1958. Since that time, it has been recorded by at least nine singers or singing groups, including Midler, The Mamas & The Papas, The Beach Boys, John Lennon, and Jan & Dean.

6. The copyright in the song "Do You Wanna Dance" is owned by Bobby Freeman Music and Clockus Music Company. Midler owns no rights in the musical work "Do You Wanna Dance".

7. Early in 1984, Y&R created an advertising campaign for Ford's Lincoln-Mercury automobiles.

8. The execution of the campaign by Y&R resulted in the production and broadcast of television commercials featuring different popular songs. "Do You Wanna Dance" was selected as one of the songs.

9. On May 21, 1985, Defendants obtained a license from Bobby Freeman Music and Clockus Music Company to synchronize and record "Do You Wanna Dance" for use in advertising Ford automobiles.

10. "Do You Wanna Dance" was presented by Y&R to Ford by playing an edited version of the Midler Record in conjunction with a proposed commercial

for the Mercury Sable Sedan. Ford approved the commercial.

11. The music producer for the advertising campaign then contacted Midler's representative to see if Y&R could obtain her services to sing the composition on the commercial. The answer was no.

12. Rebuffed by Midler, Y&R contacted Ula Hedwig. Ms. Hedwig had been employed as a singer in Midler's back-up group, the "Harlettes", for approximately ten years. As such, she had become very familiar with the songs performed by Midler.

13. Hedwig made a "demo" tape of the composition and submitted it to Y&R. Shortly thereafter, Hedwig was retained to sing for the Sable commercial by

Craig Hazen. Hazen is Vice President-Senior Music Producer at Y&R.

14. In June, 1985, Hedwig performed the composition for defendants at a recording studio in New York City. The defendants intended that the version they recorded "sound like the version that Bette Midler did." Hazen Deposition, p.74.

15. The Hedwig version of "Do You Wanna Dance" became part of the sound portion of the Sable commercial. It sounded similar to the version performed by Midler. The visual component of the commercial was comprised of images of a man and woman in formal clothing interspersed with images of the Sable automobile. The woman in the

commercial bore no resemblance to Midler.

16. The Sable commercial was broadcast extensively over nationwide television during the first six months of 1986.

17. Plaintiff filed this action against Ford and Y&R on April 29, 1986.

18. On July 13, 1987, this Court heard motions for summary judgment filed by Plaintiff Midler and Defendants Ford and Y&R. The Court granted the Defendants' motion and denied Plaintiff's motion. Specifically, the Court found that Midler had not stated a cause of action against the defendants under California law.

19. Plaintiff appealed the Court's ruling to the Ninth Circuit Court of

Appeals. On June 22, 1988, the Ninth Circuit Court of Appeals. On June 22, 1988, the Ninth Circuit reversed the grant of summary judgment to the defendants and remanded the case for trial. The court held "that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California." Midler v. Ford Motor Company, 849 F.2d 460, 463 (9th Cir. 1988).

20. In the motions currently before the Court, Plaintiff seeks summary judgment on the issue of defendants' liability for the tort of commercial appropriation of her voice, or alternatively, partial summary judgment on the

following issues: (1) that Midler has a distinctive voice, (2) that Midler is a professional singer, (3) that Midler's voice is widely known, (4) that the Defendants deliberately imitated her voice. (5) to sell a product. Plaintiff has also moved for partial summary judgment on Defendants' three affirmative defenses: (1) failure to state a claim upon which relief can be granted, (2) preemption by the federal copyright law, and (3) First and Fourteenth Amendment rights of free speech. Defendants have filed for partial summary judgment on the unavailability of punitive damages in this case.

21. There is no evidence before the Court to dispute the fact that Plaintiff is a professional singer

whose voice is widely known. See Depositions of Ula Hedwig, Ken Fritz, Rick Dees, Gerald Greenberg, Jeffrey Katzenberg, Seth Riggs, and Arif Mardin. The Court finds that she is.

22. Substantial evidence has been introduced to support the conclusion that Plaintiff has a distinctive voice. See Depositions of Ula Hedwig, Ken Fritz, Rick Dees, Gerald Greenberg, Jeffrey Katzenberg, Seth Riggs, and Arif Mardin. Moreover, defendants have offered no evidence to the contrary. The Court therefore finds that the Plaintiff has a distinctive voice.

23. It is clear that Defendants' actions were done for the purpose of selling a product.

24. Any statement of fact inappropriately designated as a conclusion of law is incorporated herein.

CONCLUSIONS OF LAW

1. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. Section 1332(a).

2. This Court has personal jurisdiction over the parties. Venue is proper in this district.

3. Because jurisdiction is based on diversity, the Court must apply the substantive law of the State of California. Erie Railroad v. Tompkins, 304 U.S. 64, 58 S.Ct. 817 (1938). See e.g., Gee v. Tenneco, Inc., 615 F.2d 857, 861 (9th Cir. 1980).

4. Summary judgment is proper "against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex Corp. v. Catrett, ___ U.S. ___, 106 S.Ct. 2548, 2652-53 (1986). Furthermore, to withstand a motion for summary judgment, the non-moving party must show that there are "genuine factual issues that properly can be resolved in favor of either party." Anderson v. Liberty Lobby, ___ U.S. ___, 106 S.Ct. 2505, 2511 (1986). See also, Cal. Arch. Bldg. Prod. v. Franciscan Ceramics, 818 F.2d 1466, 1468 (1987).

5. Plaintiff's motion for summary judgment will be granted in part and denied in part. Defendants' motion for partial summary judgment will be granted. Plaintiff's motion will be treated first.

6. It seems to the Court that the tort of "commercial appropriation of voice" has the following elements:

- (a) plaintiff is a professional singer;
- (b) plaintiff's voice is widely known;
- (c) plaintiff has a distinctive voice;
- (d) defendants deliberately imitated plaintiff's voice;
- (e) defendants did so in order to sell a product;
- (f) causation; and
- (g) damages.

7. Plaintiff has established elements (a), (b), (c), and (e) of paragraph 6. No evidence on the elements of (f) causation and (g) damages has been put before the Court.

8. As for the element of (d) deliberate imitation, the Court finds that there is an evidentiary dispute. Plaintiff has submitted the affidavit of Ula Hedwig in support of her claim that the defendants deliberately imitated her voice. Hedwig states that the Harold Wheeler, the musical arranger for the commercial, told her to sound as much as possible like the Midler record. See Hedwig Deposition, paragraph 6. She further states it was her understanding, both in getting the job and performing the song, that she

"was to imitate Bette Midler's voice as closely as possible." Hedwig Deposition, paragraph 7.

Defendants have countered this evidence by submitting the affidavits of Harold Wheeler and Craig Hazen. Wheeler unequivocally states that he neither instructed Hedwig to imitate Bette Midler (Wheeler Deposition, paragraph 4) nor did he intend that the sound track for the commercial would suggest that Midler herself was singing the song. Wheeler Deposition, paragraph 6. Hazen also denies that he ever told Hedwig to "imitate" Midler's voice. Hazen Deposition, paragraph 5. He adds that although it was not his intent to imitate Midler's voice, he understood that he could record a ver-

sion of the song that contained all of the elements of Midler's version. Hazen Deposition, paragraph 7.

Of course, there is other evidence of intent. For example, if one listened to the two recordings and decided that Hedwig "sounded" just like Midler, then that may be evidence of the defendants' intent.

On the other hand, comparing the two recordings and considering what the defendants actually said, may lead to a conclusion that they just wanted a rendition of the song that had a basic arrangement that was the same as Midler's.

In any event, the evidence on this issue is clearly in conflict and cannot

be decided at this point. This must be left for the trier of fact.

9. Plaintiff is entitled to summary judgment on defendants' three affirmative defenses because as a matter of law: (1) plaintiff has stated a cause of action, (2) that cause of action is not preempted by copyright law, and (3) freedom of speech constitutional concerns do not preclude this action. See Midler v. Ford Motor Company, 849 F.2d 460 (9th Cir. 1988).

10. Accordingly, Plaintiff's motion for summary judgment is hereby GRANTED as to the following issues:

- (a) Plaintiff is a professional singer;
- (b) Plaintiff's voice is widely known;
- (c) Plaintiff has a distinctive voice;

- (d) Defendants did what they did to sell a product;
- (e) Defendants may not avail themselves of the affirmative defenses of
 - (i) failure to state a cause of action,
 - (ii) preemption of the cause of action by the federal copyright laws, and
 - (iii) freedom of speech concerns do not preclude this action;

and DENIED as to the these remaining issues:

- (e) that defendants deliberately imitated plaintiff's voice;
- (f) causation;
- (g) and damages.

11. As noted above, Defendants' motion for partial summary judgment on the unavailability of punitive damages is granted.

12. Punitive damages are not favored by the law and should be granted with caution. See Beck v. State Farm Mutual Auto. Ins. Co., 54 Cal.App.3d 347, 355; 126 Cal.Rptr. 602 (2nd Dist. 1976).

13. Mere proof of an intentional wrong has never, standing alone, been enough to justify the imposition of punitive damages. See e.g., Flyer's Body Shop Profit Sharing Plan v. Ticor Title Ins. Co., 185 Cal.App.3d 1149, 1154-55, 230 Cal.Rptr. 276 (1st Dist.1986); Fleming v. Safeco Ins. Co., 160 Cal.App.3d 31, 44, 206 Cal.Rptr. 313 (2nd Dist.1984); Edbaugh v. Rabkin, Cal.App.3d 891, 894, 99 Cal.Rptr. 706 (1st Dist.1972).

14. In order to justify an award of punitive damages the defendant must be guilty of oppression, fraud or malice. Silberg v. California Life Ins. Co., 11 C.3d 452, 462, 113 Cal. Rptr. 711 (1974) (citations omitted). See also, Beck v. State Farm, 54 Cal.App.3d at 355-56. California defines these words in a way that leaves little doubt about the despicable type of conduct needed to justify punitive damages. See Cal.Civ.Code Section 3294.1

15. To withstand Defendants' motion for summary judgment, Plaintiff must come forth with sufficient facts to support her position that punitive damages should be assessed against these defendants. See Celotex Corp. v.

Catrett, 106 S.Ct. 2548 (1986). Moreover, those facts must be sufficient to allow a jury to find for her by "clear and convincing" evidence. Anderson v. Liberty Lobby, 106 S.Ct. 2505 (1986). See Cal.Civ.Code Section 3294. Plaintiff has not met this burden.

16. Although the Defendants intentionally made the Sable commercial, Plaintiff has not shown by clear and convincing evidence that the Defendants acted with the requisite "evil motive" to support an award of punitive damages. See Kendall Yacht Corp. v. United California Bank, 50 Cal.App.3d 949, 958, 123 Cal.Rptr. 848 (4th Dist.1975). That is particularly true since the tort in question has only recently been discovered.

17. Therefore, on the evidence before it, the Court finds that as a matter of law Plaintiff cannot obtain punitive damages in this action.

18. Accordingly, Defendants' motion for partial summary judgment on the unavailability of punitive damages is GRANTED.

19. Any conclusion of law inappropriately designated as a statement of fact is incorporated herein.

20. The Court incorporates its comments from the bench at the January 9, 1989, hearing on the motions as further explanation of its determinations.

DATED: February 8, 1989

FERDINAND F. FERNANDEZ
United States District Judge

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

BETTE MIDLER,

Plaintiff,

v.

FORD MOTOR COMPANY, et al.,

Defendants.

No. CV 86-2683 FFF (Gx)

ORDER OF SUMMARY JUDGMENT

This matter came on for hearing on January 9, 1989, on motions for summary judgment filed by Plaintiff Bette Midler, and for partial summary judgment filed by Defendants Ford Motor Company and Young & Rubicam, Inc. Peter Laird appeared on behalf of Plaintiff. Robert M. Callagy and Howard J. Privett appeared on behalf of Defendants.

The Court has considered the papers, evidence and argument of the parties and has previously entered its Statement of Uncontroverted Facts and Conclusions of Law. Plaintiffs and Defendants are entitled to summary judgment as a matter of law on the following issues:

It is therefore ORDERED AND ADJUDGED that:

- (1) Plaintiff is GRANTED summary judgment on the following issues:
 - (a) Plaintiff has a distinctive voice;
 - (b) Plaintiff is a professional singer whose voice is widely known;
 - (c) Defendants did what they did to sell a product;
 - (d) Defendants may not avail themselves of the affirmative defenses of (i) failure to state a cause of action; (ii) preemption of the cause of action by federal copyright law; and (iii) freedom of speech concerns do not preclude this action.

(2) Defendants are GRANTED summary judgment on the unavailability of punitive damages in this action.

(3) Final judgment shall not be entered on these claims at this time. Fed.R.Civ.P. 54(b).

DATED: February 8, 1989

FERDINAND F. FERNANDEZ
United States District Judge

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

BETTE MIDLER,

Plaintiff-Appellant,

v.

FORD MOTOR COMPANY, a
Delaware Corporation, and
YOUNG & RUBICAM INC., a New
York Corporation,

Defendants-Appellees.

No. 87-6168

D.C. No.

CV 86-2683-FFF

OPINION

Appeal from the United States District Court
for the Central District of California
Ferdinand F. Fernandez, District Judge, Presiding

Argued and Submitted
February 4, 1988—Pasadena, California

Filed June 22, 1988

Before: Procter Hug, Jr., Thomas Tang and
John T. Noonan, Jr., Circuit Judges.

Opinion by Judge Noonan

SUMMARY

Torts/Copyright, Patent and Trademark

Reversal and remand of judgment finding no legal principle preventing imitation of celebrity's voice. The court held that when a celebrity's distinctive voice is deliberately imitated in

order to sell a product, the sellers have appropriated what is not theirs and have committed a tort.

Appellee Ford Motor Company and its advertising agency, appellee Young & Rubicam, Inc., did some television commercials. To make an emotional connection with Yuppies, different popular songs of the seventies were sung on each commercial. In one commercial they wanted appellant Bette Midler to sing her song "Do You Want To Dance." Her manager, however, said that Midler does not do commercials. Young & Rubicam then secured Ula Hedwig, once a Midler backup singer. Hedwig succeeded in sounding very much like the Bette Midler record, just as she was instructed. At issue is only the protection of Midler's voice. The district court described the conduct as that "of an average thief." The court nonetheless believed there was no legal principle preventing imitation of Midler's voice and gave summary judgment for the appellees.

[1] Midler does not seek damages for Ford's use of the song. If she did, her claim would be preempted by federal copyright. A voice is not copyrightable. [2] Nor did appellees use Midler's name or anything else whose use would be prohibited by Cal. Civ. Code section 3344. The statute, however, does not preclude Midler from pursuing any cause of action she may have at common law. [3] A voice is as distinctive and personal as a face. To impersonate her voice is to pirate her identity.

COUNSEL

Peter Laird, Los Angeles, California, for the plaintiff-appellant.

Robert M. Callagy, New York, New York, for the defendants-appellees.

OPINION

NOONAN, Circuit Judge:

This case centers on the protectibility of the voice of a celebrated chanteuse from commercial exploitation without her consent. Ford Motor Company and its advertising agency, Young & Rubicam, Inc., in 1985 advertised the Ford Lincoln Mercury with a series of nineteen 30 or 60 second television commercials in what the agency called "The Yuppie Campaign." The aim was to make an emotional connection with Yuppies, bringing back memories of when they were in college. Different popular songs of the seventies were sung on each commercial. The agency tried to get "the original people," that is, the singers who had popularized the songs, to sing them. Failing in that endeavor in ten cases the agency had the songs sung by "sound alikes." Bette Midler, the plaintiff and appellant here, was done by a sound alike.

Midler is a nationally known actress and singer. She won a Grammy as early as 1973 as the Best New Artist of that year. Records made by her since then have gone Platinum and Gold. She was nominated in 1979 for an Academy award for Best Female Actress in *The Rose*, in which she portrayed a pop singer. *Newsweek* in its June 30, 1986 issue described her as an "outrageously original singer/comedian." *Time* hailed her in its March 2, 1987 issue as "a legend" and "the most dynamic and poignant singer-actress of her time."

When Young & Rubicam was preparing the Yuppie Campaign it presented the commercial to its client by playing an edited version of Midler singing "Do You Want To Dance," taken from the 1973 Midler album, "The Divine Miss M." After the client accepted the idea and form of the commercial, the agency contacted Midler's manager, Jerry Edelstein. The conversation went as follows: "Hello, I am Craig Hazen from Young and Rubicam. I am calling you to find out if

Bette Midler would be interested in doing . . . ? Edelstein: "Is it a commercial?" "Yes." "We are not interested."

Undeterred, Young & Rubicam sought out Ula Hedwig whom it knew to have been as one of "the Harlettes" a backup singer for Midler for ten years. Hedwig was told by Young & Rubicam that "they wanted someone who could sound like Bette Midler's recording of [Do You Want To Dance]. " She was asked to make a "demo" tape of the song if she was interested. She made an a capella demo and got the job.

At the direction of Young & Rubicam, Hedwig then made a record for the commercial. The Midler record of "Do You Want To Dance" was first played to her. She was told to "sound as much as possible like the Bette Midler record," leaving out only a few "aahs" unsuitable for the commercial. Hedwig imitated Midler to the best of her ability.

After the commercial was aired Midler was told by "a number of people" that it "sounded exactly" like her record of "Do You Want To Dance." Hedwig was told by "many personal friends" that they thought it was Midler singing the commercial. Ken Fritz, a personal manager in the entertainment business not associated with Midler, declares by affidavit that he heard the commercial on more than one occasion and thought Midler was doing the singing.

Neither the name nor the picture of Midler was used in the commercial; Young & Rubicam had a license from the copyright holder to use the song. At issue in this case is only the protection of Midler's voice. The district court described the defendants' conduct as that "of the average thief." They decided, "If we can't buy it, we'll take it." The court nonetheless believed there was no legal principle preventing imitation of Midler's voice and so gave summary judgment for the defendants. Midler appeals.

The First Amendment protects much of what the media do in the reproduction of likenesses or sounds. A primary value

is freedom of speech and press. *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967). The purpose of the media's use of a person's identity is central. If the purpose is "informative or cultural" the use is immune; "if it serves no such function but merely exploits the individual portrayed, immunity will not be granted." Felcher and Rubin, "Privacy, Publicity and the Portrayal of Real People by the Media," 88 Yale L.J. 1577, 1596 (1979). Moreover, federal copyright law preempts much of the area. "Mere imitation of a recorded performance would not constitute a copyright infringement even where one performer deliberately sets out to simulate another's performance as exactly as possible." Notes of Committee on the Judiciary, 17 U.S.C.A. § 114(b). It is in the context of these First Amendment and federal copyright distinctions that we address the present appeal.

[1] Nancy Sinatra once sued Goodyear Tire and Rubber Company on the basis of an advertising campaign by Young & Rubicam featuring "These Boots Are Made For Walkin'," a song closely identified with her; the female singers of the commercial were alleged to have imitated her voice and style and to have dressed and looked like her. The basis of Nancy Sinatra's complaint was unfair competition; she claimed that the song and the arrangement had acquired "a secondary meaning" which, under California law, was protectible. This court noted that the defendants "had paid a very substantial sum to the copyright proprietor to obtain the license for the use of the song and all of its arrangements." To give Sinatra damages for their use of the song would clash with federal copyright law. Summary judgment for the defendants was affirmed. *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717-718 (9th Cir. 1970), *cert. denied*, 402 U.S. 906 (1971). If Midler were claiming a secondary meaning to "Do You Want To Dance" or seeking to prevent the defendants from using that song, she would fail like Sinatra. But that is not this case. Midler does not seek damages for Ford's use of "Do You Want To Dance," and thus her claim is not preempted by federal copyright law. Copyright protects "original

works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). A voice is not copyrightable. The sounds are not "fixed." What is put forward as protectible here is more personal than any work of authorship.

[2] Bert Lahr once sued Adell Chemical Co. for selling Lestoil by means of a commercial in which an imitation of Lahr's voice accompanied a cartoon of a duck. Lahr alleged that his style of vocal delivery was distinctive in pitch, accent, inflection, and sounds. The First Circuit held that Lahr had stated a cause of action for unfair competition, that it could be found "that defendant's conduct saturated plaintiff's audience, curtailing his market." *Lahr v. Adell Chemical Co.*, 300 F.2d 256, 259 (1st Cir. 1962). That case is more like this one. But we do not find unfair competition here. One-minute commercials of the sort the defendants put on would not have saturated Midler's audience and curtailed her market. Midler did not do television commercials. The defendants were not in competition with her. *See Halicki v. United Artists Communications, Inc.*, 812 F.2d 1213 (9th Cir. 1987).

[2] California Civil Code section 3344 is also of no aid to Midler. The statute affords damages to a person injured by another who uses the person's "name, voice, signature, photograph or likeness, in any manner." The defendants did not use Midler's name or anything else whose use is prohibited by the statute. The voice they used was Hedwig's, not hers. The term "likeness" refers to a visual image not a vocal imitation. The statute, however, does not preclude Midler from pursuing any cause of action she may have at common law; the statute itself implies that such common law causes of action do exist because it says its remedies are merely "cumulative." *Id.* § 3344(g).

The companion statute protecting the use of a deceased person's name, voice, signature, photograph or likeness states that the rights it recognizes are "property rights." *Id.* § 990(b). By analogy the common law rights are also property rights.

Appropriation of such common law rights is a tort in California. *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821 (9th Cir. 1974). In that case what the defendants used in their television commercial for Winston cigarettes was a photograph of a famous professional racing driver's racing car. The number of the car was changed and a wing-like device known as a "spoiler" was attached to the car; the car's features of white pinpointing, an oval medallion, and solid red coloring were retained. The driver, Lothar Motschenbacher, was in the car but his features were not visible. Some persons, viewing the commercial, correctly inferred that the car was his and that he was in the car and was therefore endorsing the product. The defendants were held to have invaded a "proprietary interest" of Motschenbacher in his own identity. *Id.* at 825.

Midler's case is different from Motschenbacher's. He and his car were physically used by the tobacco company's ad; he made part of his living out of giving commercial endorsements. But, as Judge Koelsch expressed it in *Motschenbacher*, California will recognize an injury from "an appropriation of the attributes of one's identity." *Id.* at 824. It was irrelevant that Motschenbacher could not be identified in the ad. The ad suggested that it was he. The ad did so by emphasizing signs or symbols associated with him. In the same way the defendants here used an imitation to convey the impression that Midler was singing for them.

Why did the defendants ask Midler to sing if her voice was not of value to them? Why did they studiously acquire the services of a sound-alike and instruct her to imitate Midler if Midler's voice was not of value to them? What they sought was an attribute of Midler's identity. Its value was what the market would have paid for Midler to have sung the commercial in person.

A voice is more distinctive and more personal than the automobile accouterments protected in *Motschenbacher*. A voice is as distinctive and personal as a face. The human

voice is one of the most palpable ways identity is manifested. We are all aware that a friend is at once known by a few words on the phone. At a philosophical level it has been observed that with the sound of a voice, "the other stands before me." D. Ihde, *Listening and Voice* 77 (1976). A fortiori, these observations hold true of singing, especially singing by a singer of renown. The singer manifests herself in the song. To impersonate her voice is to pirate her identity. See W. Keeton, D. Dobbs; R. Keeton, D. Owen, *Prosser & Keeton on Torts* 852 (5th ed. 1984).

We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California. Midler has made a showing, sufficient to defeat summary judgment, that the defendants here for their own profit in selling their product did appropriate part of her identity.

REVERSED AND REMANDED FOR TRIAL.

PRINTED FOR
ADMINISTRATIVE OFFICE—U.S. COURTS
BY BARCLAYS / ELECTROGRAPHIC—SAN FRANCISCO—(415) 588-1155

The summary, which does not constitute a part of the opinion of the court, is
copyrighted © 1988 by Barclays Law Publishers.

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

BETTE MIDLER,

Plaintiff,

vs.

FORD MOTOR COMPANY, a
Delaware corporation, and
YOUNG & RUBICAM, INC., a
New York corporation,

Defendants.

CV 86-2683 FFF

STATEMENT OF UNCONTROVERTED
FACTS AND CONCLUSIONS OF LAW

This matter came on for hearing on July 13, 1987 on motions for summary judgment filed by plaintiff Bette Midler and defendants Ford Motor Company and Young & Rubicam, Inc. Peter Laird and William R. Sobel of Arrow, Edelstein & Gross appeared on behalf of

the plaintiff. Robert M. Callagy and Mario A. Aieta of Satterlee & Stephens appeared on behalf of defendants.

The Court has considered the papers, evidence and argument of the parties and hereby enters the following statement of uncontroverted facts and conclusions of law.

STATEMENT OF UNCONTROVERTED FACTS

1. Plaintiff Bette Midler ("Midler"), a citizen of California, is a well-known recording artist, concert performercomedienne and motion picture actress.

2. Defendant Ford Motor Company ("Ford") is a Delaware corporation with its principal place of business in the state of Michigan. Ford is engaged in

the manufacture, advertising, and sale of motor vehicles and other products.

3. Defendant Young & Rubicam, Inc. ("Young & Rubicam") is a New York corporation with its principal place of business in New York. Young & Rubicam is an advertising agency and has Ford as one of its clients.

4. Midler's first record album, "Bette Midler -- The Divine Miss M," was released in 1972. The first song on side one of the album is "Do You Want To Dance." (Hereinafter, the song is sometimes referred to as the "composition".) A 45-rpm single version of the Midler Record was also released. It received extensive radio air-play, and was on the Billboard singles chart and other music trade charts. Midler

regularly performed the composition on concert tours for more than a decade. One such live concert performance was recorded, and the composition was again released by Midler in 1977 on a phonograph album entitled "Bette Midler, Live at Last."

5. Bobby Freeman wrote "Do you Wanna Dance" in 1958.¹ Since that time, it has been recorded by at least nine singers or singing groups, including Midler, The Mamas & The Papas, The Beach Boys, John Lennon, and Jan & Dean.

6. The copyright in the song "Do You Wanna Dance" is owned by Bobby Freeman Music and Clockus Music Company.

1/The fact the Freeman song is titled "Do You Wanna Dance" and the Midler Record "Do You Want To Dance" is of no significance to this case.

Midler owns no rights in the musical work "Do You Wanna Dance."

7. Early in 1984, Young & Rubicam created an advertising campaign for Ford's Lincoln-Mercury automobiles.

8. The execution of the campaign by Young & Rubicam resulted in the production and broadcast of television commercials featuring 19 different popular songs. "Do You Wanna Dance" was selected as one of the songs.

9. On May 21, 1985 defendants obtained a license from Bobby Freeman Music and Clockus Music Company to synchronize and record "Do You Wanna Dance" for use in advertising Ford's automobiles.

10. "Do You Wanna Dance" was presented by Young & Rubicam to Ford by

playing an edited version of the Midler Record in conjunction with the proposed commercial for the Mercury Sable Sedan. Ford approved the commercial.

11. The music producer for the advertising campaign then contacted Midler's representative to see if Young & Rubicam could obtain her services to sing the composition on the commercial. The answer was no.

12. Having been rebuffed by Midler, Young & Rubicam contacted Ula Hedwig. Ms. Hedwig had been employed as a singer in Midler's back-up group, the "Harlettes," for approximately 10 years. As such, she had become very familiar with the songs performed by Midler.

13. Hedwig made a "demo" tape of the composition and submitted it to Young & Rubicam. Shortly thereafter, Hedwig was retained to sing for the Sable commercial by Craig Hazen. Hazen is Vice President-Senior Music Producer at Young & Rubicam.

14. In June, 1985 Hadwig performed the composition for defendants at a recording studio in New York City. At the recording session it was the intent of defendants that "the version we were doing would sound like the version that Bette Midler did." (Hazen deposition at p. 74.)

15. The Hedwig version of "Do YOu Wanna Dance" became part of the sound portion of the Sable commercial. It used a combination of voice, style,

arrangement and melody that was quite similar to the version performed by Midler. The visual component of the commercial was comprised of images of a man and woman in formal clothing interspersed with images of the Sable automobile. The woman in the commercial bore no resemblance to Midler.

16. The Sable commercial was broadcast extensively over nationwide television during the first six months of 1986.

17. Plaintiff filed the instant action against Ford and Young & Rubicam on April 29, 1986. A First Amended Complaint was filed on May 27, 1986.

18. The First Amended Complaint asserts causes of action for (1) Violation of California Civil Code § 3344;

(2) Invasion of Privacy; (3) Infringement of Right of Publicity; (4) Unfair Competition; (5) Injunctive Relief; and (6) an Accounting.

19. On May 18, 1987 the Court denied as untimely plaintiff's motion for leave to amend to allege a claim under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

20. The matter is now before the Court on motions for summary judgment filed by both plaintiff and the defendants. Midler submits that defendants should be found liable as a matter of law under each of the causes of action in the First Amended Complaint pertaining to liability. Ford and Young & Rubicam argue that under the disputed facts plaintiff cannot state a claim

under the common law of privacy, publicity, or unfair competition and that, in any event, plaintiff's state law claims are all preempted by the federal copyright laws.

21. California Civil Code § 3344 provides that:

Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, on or in products, merchandise, or goods, or for purposes of advertising or selling, or soliciting purchases of, products, merchandise, goods or services, without such person's prior consent, . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.

22. Any statement of fact inappropriately designated as a conclusion of law is incorporated herein.

CONCLUSIONS OF LAW

1. The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1332(a).

2. The Court has personal jurisdiction over the parties. Venue is proper in this district.

3. Since jurisdiction is founded upon diversity of citizenship, the Court must apply the substantive law of the forum state, California. Erie Railroad v. Tompkins, 304 U.S. 64, 58 S.Ct. 817 (1938); Kabatoff v. Safeco Insurance Company, 627 F.2d 207 (9th Cir. 1980).

4. Under the facts of this case, it is pellucid that plaintiff has no

protectable rights under the laws of California.²

5. First, plaintiff does not have a viable claim for unfair competition, invasion of privacy, or infringement of right of publicity. Plaintiff points to no cases wherein a right of privacy or publicity has been found to exist in the situation of imitation of voice alone. As for the unfair competition claim, the Ninth Circuit disposed of that claim in no uncertain terms in Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir. 1970). The

²/Moreover, if California sought to confer those rights upon plaintiff, it would seriously risk running afoul of the federal copyright laws. The Court, however, need not, and does not decide this issue. The Court simply notes that the "the Shadows of" preemption do fall across this case. Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711, 717 (9th Cir. 1970). See, 17 U.S.C. § 301(a).

Court recognizes that plaintiff attempts to circumvent Sinatra by contending her voice alone is so unique that upon hearing a voice anything like hers the public would think that it was no one but Midler. In so doing, plaintiff appears to be trying to place herself within the decision in Lahr v. Adell Chemical Co., 300 F.2d 256 (1st Cir. 1962). However, plaintiff presents no evidence to support that proposition, and, at least to this Court's untrained ear, it is very unlikely that she could. Defendants are entitled to summary judgment on plaintiff's claims for unfair competition, invasion of privacy and infringement of right of publicity.

Indeed, the Sinatra court emphasized that the deliberate attempt to sound like a particular singer does not constitute unfair competition as "Lahr was decided on the basis of a singular uniqueness of quality of voice that made his situation not just a difference of degree but a difference in kind." Sinatra Goodyear Tire & Rubber Co., 435 F.2d at 716. See also Booth v. Colgate-Palmolive Co., 362 F.Supp. 343 (S.D.N.Y. 1973).

6. Second, plaintiff's claim under California Civil Code § 3344 is also without merit. Plaintiff submits that the section purports to offer protection against sound-alikes. The Court disagrees. In fact, the plain language of the statute itself belies plaintiff's position. Section 3344 speaks of using another's "photograph, or likeness." Had the statute limited itself to photographs, one would be hard-pressed to find that the statutory language covered a sketch, a painting, or a dressed-up actor surrounded by props to help the actor look like the plaintiff. See e.g., Onassis v. Christian Dior-New York, Inc., 472 N.Y.S. 2d 254 (N.Y. Sup.Ct. 1984).

However, with the inclusion of "or likeness" the protection of section 3344 was extended to cover simulacra.

That is, the statute precludes the use of methods that clearly evoke one's visage when the visage itself is not being used. On the other hand, when the California legislature placed the word "voice" in section 3344, it did not go on to indicate that the imitation of a voice was also covered, and, at least in normal usage, it would be surprising to find that the word "likeness" refers to voice in the context of the statute.

In other words, section 3344 prohibited the defendants from taking the plaintiff's voice and using it in any manner. That does not mean they were precluded from using a voice that sounded like the plaintiff's. Defendants are also entitled to summary judgment on plaintiff's cause of action for violation of California Civil Code § 3344.

7. Plaintiff claims that since what defendants did was not proper, and since this type of activity is increasing, it is unfair to deny her a remedy. The Court recognizes that the result may seem harsh, at first glance, but as the Ninth Circuit noted in Sinatra, plaintiff could have protected herself by purchasing the copyright from its owner. Moreover, if song stylists are to be protected, it is possible that the protection will be at the expense of the copyright holder. Specifically, he will see the economic value of his rights depleted, since those who wish to perform his song may have to purchase rendition rights from others, if they wish to avoid litigation. All of these competing claims urge caution.

That caution should restrain courts from acting on the basis of their own moral sensibilities. It should encourage them to leave the issue to the legislative branch which is in a much better position to take account of the claims of all of the competing interests.

8. Accordingly, defendants' motion for summary judgment is hereby GRANTED and plaintiff's DENIED.

9. Any conclusion of law inappropriately designated as a statement of fact is incorporated herein.

10. The Court incorporates its comments from the bench on July 13, 1987 as a further explanation of its determinations.

DATED: August 12, 1987

FERDINAND F. FERNANDEZ
United States District Judge

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

BETTE MIDLER,

Plaintiff,

vs.

FORD MOTOR COMPANY, a
Delaware corporation, and
YOUNG & RUBICAM INC., a
New York corporation,

Defendants.

CV 86-2683 FFF

JUDGMENT

This matter came on for hearing on July 13, 1987 on motions for summary judgment filed by plaintiff Bette Midler and defendants Ford Motor Company and Young & Rubicam, Inc. Peter Laird and William R. Sobel of Arrow, Edelstein & Gross appeared on behalf of the plaintiff. Robert M. Callagy and Mario A. Aieta of Satterlee

Stephens appeared on behalf of the defendants.

The Court having duly considered the papers submitted in support of and opposition to the motions, and the Court, having previously entered its findings of uncontroverted facts and conclusions of law, and the Court having found that there is no genuine dispute as to any material fact and that defendants are entitled to summary judgment as a matter of law:

IT IS HEREBY ORDERED, ADJUDGED AND DECREED that defendants' motion for summary judgment be, and is, hereby GRANTED and plaintiff's DENIED. Defendants shall recover costs in the amount of _____.

DATED: August 12, 1987.

FERDINAND F. FERNANDEZ
United States District Judge

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

BETTE MIDLER,
Plaintiff-Appellant,
v.
FORD MOTOR COMPANY, a Delaware
Corporation, and YOUNG & RUBICAM INC.,
a New York Corporation,
Defendants-Appellees.

No. 87-6168
DC# CV 86-2683-FFF

ORDER

Before: HUG, TANG, and NOONAN,
Circuit Judges.

The panel as constituted in the
above case has voted to deny the
petition for rehearing and to reject
the suggestion for rehearing en banc.

The full court has been advised of
the suggestion for en banc rehearing,

and no judge of the court has requested a vote on the suggestion for rehearing en banc. Fed. R. App. P. 35(b).

The petition for rehearing is denied, and the suggestion for rehearing en banc is rejected.

17 U.S.C. § 101. Definitions

As used in this title, the following terms and their variants mean the following:

[in relevant part]

A work is "fixed" in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration. A work consisting of sound, images, or both, that are being transmitted, is "fixed" for purposes of this title if a fixation of the work is being made simultaneously with its transmission.

§ 102. Subject matter of copyright:
In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

§ 106. Exclusive rights in copyrighted works

Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

§ 114. Scope of exclusive rights in sound recordings

(a) The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), and (3) of section 106, and do not include any right of performance under section 106(4).

(b) The exclusive right of the owner of copyright in a sound recording under clause (1) of section 106 is limited to the right to duplicate the sound recording in the form of phonorecords, or of copies of motion pictures and other audiovisual works, that directly or indirectly recapture the actual sounds fixed in the recording. The exclusive right of the owner of copyright in a sound recording under clause (2) of section 106 is limited to the right to prepare a derivative work in which the actual sounds fixed in the actual recording are arranged, remixed, or otherwise altered in sequence or quality. The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of section 106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording. The exclusive rights of the owner of copyright in a sound recording under clauses (1), (2), and (3) of section 106 do not apply to sound recordings included in educational television and radio programs (as defined in section 397 of

title 47) distributed or transmitted by or through a public broadcasting entities (as defined by section (118(g))): Provided, That copies or phonorecords of said programs are not commercially distributed by or through public broadcasting entities to the general public.

(c) This section does not limit or impair the exclusive right to perform publicly, by means of a phonorecord, any of the works specified in section 106(4).

(d) On January 3, 1978, the Register of Copyrights, after consulting with representatives of owners of copyrighted materials, representatives of the broadcasting, recording, motion picture, entertainment industries, and art organizations, representatives of organized labor and performers of copyrighted materials, shall submit to the Congress a report setting forth recommendations as to whether this section should be amended to provide for performers and copyright owners of copyrighted material any performance rights in such material. The report should describe the status of such rights in foreign countries, in views of major interested parties, and specific legislative or other recommendations, if any.

§115. Scope of exclusive rights in nondramatic musical works: Compulsory license for making and distributing phonorecords

In the case of nondramatic musical works, the exclusive rights provided by clauses (1) and (3) of section 106, to make and to distribute phonorecords of such works, are subject to compulsory licensing under the conditions specified by this section.

(a) Availability and scope of compulsory license.

(1) When the phonorecords of a nondramatic musical work have been distributed to the public in the United States under the authority of the copyright owner, any other person may, by complying with the provisions of this section, obtain a compulsory license to make and distribute phonorecords of the work. A person may obtain a compulsory license only if his or her primary purpose in making phonorecords is to distribute them to the public for private use. A person may obtain a compulsory license for use of the work in the making of phonorecords duplicating a sound recording fixed by another, unless: (i) such sound recording was fixed lawfully; and (ii) the making of the phonorecords was authorized by the owner of copyright in the sound recording or, if the sound recording was fixed before February 15, 1972, by any person who fixed the sound recording pursuant to an express license from the owner of the copyright in the musical

work or pursuant to a valid compulsory license for use of such work in a sound recording.

(2) A compulsory license includes the privilege of making a musical arrangement of the work to the extent necessary to conform it to the style or manner of interpretation of the performance involved, but the arrangement shall not change the basic melody or fundamental character of the work, and shall not be subject to protection as a derivative work under this title, except with the express consent of the copyright owner.

§ 301. Preemption with respect to other laws

(a) On and after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106 in works of authorship that are fixed in a tangible medium of expression and come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to any such right or equivalent right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to —

(1) subject matter that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression; or

(2) any cause of action arising from undertakings commenced before January 1, 1978; or

(3) activities violating legal or equitable rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106.

(c) With respect to sound recordings fixed before February 15, 1972, any rights or remedies under the common law or statutes of any State shall not be annulled or limited by this title until February 15, 2047. the preemptive provisions of subsection (a) shall apply to any such rights and remedies pertaining to any cause of action arising from undertakings commenced on and after February 15, 2047. Notwithstanding the provisions of section 303, no sound recording fixed before February 15, 1972, shall be subject to copyright under this title before, on, or after February 15, 2047.

